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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,198	12/02/2003	Simon Robert Walmsley	PEA23US	4548
24011	7590	05/12/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD			TON, MY TRANG	
393 DARLING STREET			ART UNIT	
BALMAIN, 2041			PAPER NUMBER	
AUSTRALIA			2816	

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JK

Office Action Summary	Application No. 10/727,198	Applicant(s) WALMSLEY, SIMON ROBERT	
	Examiner My-Trang N. Ton	Art Unit 2816	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


MY-TRANG NUTON
PRIMARY EXAMINER

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/02/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure remains objected to because of the following informalities:

Some of the subject matter disclosed in the specification is entirely outside the bounds of the presently claimed invention. As pointed out by Applicant, all claims are appeared to read directly on Fig. 411, it is not seen where the specification of from 10-50 pages with not adequately support this figure. While it is appreciate that a great deal of work is required to comply with this requirement, the burden of providing a disclosure to the public in compliance with the statutes is a far greater one.

Appropriate correction is required.

Drawings

The corrected drawings were received on 3/03/05. These drawings are approved.

Claim Rejections - 35 USC § 112

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 depends with the canceled claim 2. Did applicant intend for this claim to be canceled?

Claim Rejections - 35 USC § 102

Claims 1, 3-6 remain rejected under 35 U.S.C. 102(b) as being anticipated by Kitano (U.S Patent No. 5,870,267) for the reasons recited in the last Office action.

Claims 1, 3-6 also remain rejected under 35 U.S.C. 102(b) as being anticipated by Kawai et al (U.S Patent No. 6,560,164) for the reasons recited in the last Office action.

Regarding the limitation "in the invent that the temperature is below a predetermined temperature range" recited in claim 1, under broadest reasonable interpretation, temperature range can be any value, such as infinitive.

Response to Arguments

Applicant's arguments filed 3/03/05 have been fully considered but they are not persuasive.

Examiner has thoroughly reviewed Applicant's arguments but firmly believes that the two cited references reasonably and properly meet the claimed limitation as rejected.

Applicant's argument - the present invention is to prevent attempts to intentionally cause malfunction of a circuit by applying external heating or cooling. Changing the temperature of an integrated circuit outside of its safe operating temperature can cause unpredictable behavior of the logic within the circuit.

Examiner's response -- In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e, prevent attempts to intentionally cause malfunction of a circuit by applying external heating or cooling. Changing the temperature of an

integrated circuit outside of its safe operating temperature can cause unpredictable behavior of the logic within the circuit) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Moreover, Applicant's argument – claim 1 is limited to "under temperature detection".

Examiner's response -- Similarly as noted above, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the feature upon which applicant relies (i.e, under temperature detection) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Therefore, these claims are not seen to distinguish the present invention over the prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Trang N. Ton whose telephone number is 571-272-1754. The examiner can normally be reached on 7:00 a.m - 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Callahan can be reached on 571-272-1740. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


My-Trang N. Ton
Primary Examiner
Art Unit 2816

May 10, 2005